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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,480	06/28/2001	Giuseppe Colombo	05788.0170	2907

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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,480

Applicant(s)

COLOMBO ET AL.

Examiner

Elena Tsoy

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-- **Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-66 is/are pending in the application.
- 4a) Of the above claim(s) 49-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-38, 40-42, 47 and 48 is/are rejected.
- 7) ☐ Claim(s) 39 and 43-46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Amendment

1. Amendment filed on July 22, 2003 has been entered. Claims 34-66 are pending in the application. Claims 49-66 are withdrawn from consideration as directed to a non-elected invention.

Priority

2. The Examiner acknowledges that a wrong box was checked in the Office Action Summary. All certified copies of the priority documents had been received by the Office.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 34-38, 40-42, 47, 48** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tate et al (US 4,035,322) in view of Nishida et al (US 6,186,658), and further in view of Hiorth (US 4,191,480) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on April 25, 2003 (Paper No. 17).

Allowable Subject Matter

5. Claims 39, 43-46 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on April 25, 2003 (Paper No. 17).

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Response to Arguments

6. Applicants' arguments filed July 22, 2003 have been fully considered but they are not persuasive.

(A) Applicants argue that Tate et al in view of Nishida et al in view of Hiorth teach away from the claimed invention because three basic criteria to establish prima facie case of obviousness such as (A) motivation to combine, (B) reasonable expectation of success, and (C) the cited combined references must teach or suggest all the claim limitations were not met.

The Examiner respectfully disagrees with this argument.

As to (A), there is motivation to combine Tate et al and Nishida et al since in contrast to Tate et al, a process of Nishida et al provides rapid and uniform mixing particles of the same size with a liquid coating. Furthermore, it is held that the substitution of one known equivalent technique for another may be obvious even if the prior art does not expressly suggest the substitution. Ex parte Novak 16 USPQ 2d 2041 (BPAI 1989); In re Mostovych 144 USPQ 38 (CCPA 1964); In re Leshin 125 USPQ 416 (CCPA 1960); Graver Tank & Manufacturing Co. v. Linde Air Products Co. 85 USPQ 328 (USSC 1950).

As to (B), there is reasonable expectation of success in applying Nishida et al to Tate et al because both processes are directed to mixing heated particles of the same size with a liquid coating. Applicants argue that process parameters such as high temperature of 450-700⁰C enough to evaporate the heavy oil in Nishida et al cannot be applied to a mixing process of Tate et al since it will decompose the curing agent. However, one of ordinary skill in the art at would not use process parameters for mixing catalyst particles with heavy oil for mixing and coating plastic particles with a curing agent, i.e. one of ordinary skill in the art at would not coat particles at decomposition temperature of a coating material. For example, the same process, e.g. a fluidized

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bed, can be used for wide range of particles, whether inorganic or organic, including plastic and catalyst particles, with wide range of coating materials including heavy oil and liquid curing agent using wide ranges of temperatures including 50⁰C and 450-700⁰C depending on particular application. In other words, if static mixing of heated particles with a liquid material was carried out at 450-700⁰C it does not mean that plastic particles should be coated with a liquid curing agent at the same high temperature, especially at a decomposition temperature of coating materials. Furthermore, it is held that the selection of reaction parameters such as temperature and concentration would have been obvious.

As to (C), Applicants argue that Hiorth teaches away because in column 6, lines 54-68, Hiorth states that the resultant spray which after mixing may have a very sticky or adhesive consistency, may immediately be passed into a post-mixing and screw-conveyor system able to handle plastic material.

However, Hiorth this statement applies only one of various disclosed embodiments. In another embodiment Hiorth does teach drying coating particles: "The mixed product is then, entrained in the air stream, discharged through an exit 35 in the lower part of the mixing chamber. When the above described mixing process is carried out in a factory the finished product may be loaded directly into so-called valve-bags without the need for an expensive fluidizing packer" (See column 4, lines 42-54). Since it is well known in the art that valve-bags are used for dispensing a flowable product, it is this embodiment is hardly directed to sticky particles.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Elena Tsoy
Examiner
Art Unit 1762

August 11, 2003


SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700